



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,232	05/21/2001	Greg Arnold	PALM-3649.US.P	9948
7590 07/21/2008 WAGNER, MURABITO & HAO LLP Third Floor Two North Market Street San Jose, CA 95113			EXAMINER SHIN, KYUNG H	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 07/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/863,232

Applicant(s)

ARNOLD ET AL.

Examiner

KYUNG H. SHIN

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Response to Amendment

1. This application was filed 5/21/2001.
2. Claims **1 - 24** are pending. Independent Claims are **1, 12 and 21**.

Response to Arguments

3. Applicant's arguments filed **4/9/2008** have been fully considered but they are not persuasive.

3.1 Applicant argues, user accounting versus device accounting (Remarks Page 3, 6).

Applicant has mentioned that there is a fundamental difference between accounting information based on a user as opposed to a device. Applicant mentioned that one user can have multiple devices. But, one device can have multiple users. The accounting or profile information for each device and each user in each situation would be cognizant of the particular operational environment. In one situation, the accounting information for the device must recognize that multiple users are using the device. On the other hand, the accounting information for the user must recognize that a user has multiple devices. Accounting information must take into account how many users and how many devices are attached to this particular account. The accounting information is data that is manipulated by the computer systems performing the synchronization procedure. This change would not change the operation of Multer since information such accounting data can still be synchronized between two computing systems.

Multer discloses the management of accounting information. (Multer col 17, ll 15-20; col 32, ll 14-17: accounting information updated and stored on server) And, the Multer and Coppinger combination discloses a server for the registration, storage, and management of accounting information for a particular wireless (mobile computing) device including information designating a user for the particular device. (Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless or mobile device accounting information with a network connected server)

3.2 Applicant argues there is no disclosure of a complement of accounting information, only the creation of an account (Remarks Page 3, 7)

Coppinger discloses the creation of an account. In addition, Coppinger discloses a complement of information within an account. (see Coppinger paragraph [0059]: creation and complement of accounting information) and the usage of an account (Coppinger para 44, ll 4-10: accessible via the Internet (suitable passwords and accounts presumed to be in place))

3.3 Applicant argues version information (Remarks Pages 3, 11).

Multer discloses versioning utilizing a version number per object. (Multer col 12, ll 10-12), and each application has an application object. Multer discloses the processing of application programs, its version information, and the capability to match (i.e. synchronize) applications between systems (i.e. handheld devices). (Multer col 12, ll 10-12; col 15, ll 10-11; col 15, ll 27-30: application information processed)

3.4 Applicant argues that a datapack or equivalent token does not "causes said account to be modified by said remote server" (Remarks page 4, 13, 14)

Multer discloses that the data packages are not after the fact logs of synchronization procedures. The datapack is a set of procedures required for updating one computer system and placing it in synchronization with another computer system whether handheld or mobile computing systems. (Multer para 010, ll 48-51: steps necessary for applying data packages to the local format required for the type of information)

Multer discloses that the datapack information is applied to update the information. This disclosure indicates that the data pack is not an after the fact data entity but an entity that causes (applying information) the accounting (information, data) to be updated.

Multer discloses that the datapack is equivalent to the token. It is not a requirement to disclose a token, when the prior art named entity, the datapack, performs an equivalent function. A token is defined as an entity to identify information. A token causes the account information to be modified, and Multer's datapack causes the particular accounting information and data on the handheld device or mobile computing device to be modified. Multer discloses a data package (datapack), which is utilized to identify information. (Multer col 10, ll 26-31; col 37, ll 62-65: data package, change information)

In addition, Multer's data pack is not a record of transactions that have already

been completed. The datapack is a series of transactions. There is no disclosure within the prior art that the datapack is an after the fact entity.

3.5 Applicant on page 7 states that Coppinger teaches accounting information for a single wireless device and has absolutely nothing to do with a second wireless device. Then, on Page 8 applicant states that Coppinger teaches wireless synchronization directly between wireless devices or multiple devices. Coppinger discloses a server system acting as an intermediary between wireless or mobile computing devices. Coppinger provides accounting information on a device basis as per claimed limitation. Coppinger discloses communications between a wireless device and a server. (Coppinger para 009, ll 1-13: application program transferred for communications between wireless device and server)

3.6 Applicant argues the determination of new information.

Applicant states that Multer determines information is new because it is on the remote server (Remarks Page 4). Then applicant states that Multer determines information is new because of its interaction with the second device (Remarks Page 12). Both situations applicant states are incorrect for the particular situation. This disclosure is one example of a determination of new information that must be synchronized between the two computing systems. The claimed invention discloses that the server determines when new information needs to be added or synched between a first and second mobile computing devices. Multer discloses that the server

Art Unit: 2143

determines when information is new and needs to be synched between the two mobile computing systems. The accounting information must be accessed by the server in order to determine that said accounting information contains new information.

3.7 Applicant argues the "dependent claims". (Remarks Pages 15, 16)

Arguments for dependent claims are based upon above arguments for independent claims 1, 12, 21. The successful responses to arguments for independent claims 1, 12, 21, also successfully respond to the current arguments against the dependent claims 2-11, 13-20, 22-24.

3.8 To teach away, a reference must criticize or discourage a particular embodiment of an invention within a prior art. There is no disclosure in Multer that discredits, discourages the usage of information on a device basis. Accounting information is information about a particular entity, whether it is a user or a device. The prior art's treatment of a user is equivalent to Applicant invention's treatment of a device. The Applicant accounting information maintained for the device can be application and application version information. The prior art discloses that the accounting information maintained for the user can be application and application version information. (Multer col 8, ll 40-44) The information maintained for Applicant's claimed invention and referenced prior art are equivalent.

The combination of Multer and Coppinger disclose the claim limitations of the claimed invention and does not render the combination inoperable.

Applicant is reminded that, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). (refer MPEP 2145.X.D.1)

3.9 The claim limitations have been amended to replace "handheld" with "mobile computing" for the type of device. This does not change the basis of the rejection since a handheld device is one example of a mobile computing device.

Multer and Coppinger disclose the processing of data such as application programs and the capability to synchronize applications between systems whether handheld devices or mobile computing devices. Multer discloses the datapack an equivalent entity to the token to indicate the required modification in order to synchronize two computing system. Coppinger discloses the usage of device accounting information equivalent to the user accounting information disclosed by Multer. Multer discloses (Multer col 15, ll 10-11; col 15, ll 27-30: application information processed; Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless (mobile computing) device accounting information on a network connected server; para 071, ll 28-37: communication connection between server and other wireless (mobile computing) device)

Therefore, the rejection of claims 1 - 24 is proper and maintained herein.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1 - 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Multer et al.** (US Patent No. 6,757,696) in view of **Coppinger et al.** (US PGPub No. **20010046862**).

Regarding Claim 1, Multer discloses a method of transferring information comprising the steps of:

- b) modifying said account to identify an information that resides on said remote server but not on said second mobile computing device; (Multer col 17, ll 15-20; col 32, ll 14-17: accounting information updated and stored on server)

Multer discloses wherein said remote server automatically determining, from said account that said information is new to said second handheld device and in response thereto for automatically downloading said information to said second mobile computing device. (Multer col 34, ll 23-29: user information updated (i.e. new information)) Multer does not specifically disclose the capability for a remote server, and accessing an account stored on said remote server said account reserved for a

second mobile computing device,.

However, Coppinger discloses:

- a) at a remote server, responsive to a receiving signal from a first mobile computing device, accessing an account stored on said remote server, said account reserved for a second mobile computing device, said account describing information that is not stored in said second mobile computing device;
(Coppinger para 059, II 1-34; para 060, II 1-7; para 060, II 21-29: wireless (mobile computing) device accounting information on a network connected server)
- c) responsive to establishing a connection with said second mobile computing device. (Coppinger para 071, II 28-37: communication connection between server and other wireless (mobile computing) device)

It would have been obvious to one of ordinary skill in the art to modify Multer for a remote server and accessing an account stored on said remote server plus establishing a connection with said second mobile computing device as taught by Coppinger. One of ordinary skill in the art would have been motivated to employ the teachings of Coppinger in order to enable the additional and extended capability for the transfer over the wireless communication link and execution of transferred application programs on a handheld wireless device. (Coppinger para 003, II 7-13: “
... Recently developed wireless devices permit a program to be transferred via the wireless link (e.g., downloaded) for storage in the memory and for execution as an application program. Such an application program may define unique displays for acquiring data input by the user and provide for transfer of resulting data via the

wireless link (e.g., upload) to a conventional desktop computer. ... ")

Regarding Claim 2, Multer discloses a method as described in Claim 1 further comprising the step of said remote server receiving a token identifying said information and said second mobile computing device, and wherein said token causes said account to be modified by said remote server. (Multer col 37, ll 62-65: data pack (i.e. token) used for information transfer utilized for update)

Regarding Claims 3, 14, Multer discloses a method, system as described in Claims 1, 12 wherein the first and said second mobile computing or said sender and said receiver mobile computing are portable electronic computer systems. (Multer col 4, ll 27-36: two devices (i.e. handheld devices) in communication)

Regarding Claims 4, 15, 23, Multer discloses a method, system as described in Claims 1, 12, 21 wherein said information is a version of an application program. (Multer col 12, ll 10-12; col 12, ll 16-20; col 13, ll 3-7: version information processed)

Regarding Claims 5, 16, 24, Multer discloses a method, system as described in Claims 4, 15, 21 wherein said account comprises an application version record table comprising an entry for each application stored in said second mobile computing device and wherein each entry comprises: an application identifier; a version identifier; and a user identifier. (Multer col 38, ll 3-5 col 38, ll 8-15; col 38, ll 55-59: identifiers utilized to

designate contents within table entries)

Regarding Claim 6, Multer discloses a method as described in Claim 1 wherein the step of automatically downloading said information to said second mobile computing device, of step d), is performed only if said first mobile computing device has authority to download to said second mobile computing device. (Multer col 33, ll 13-17; col 34, ll 23-29; col 5, ll 17-21: authentication for device based on account information, download information)

Regarding Claims 7, 18, Multer discloses a method, system as described in Claims 6, 17 wherein said authority is established via an express grant of permission from said second mobile computing device to said first mobile computing device. (Multer col 34, ll 16-19: authorization for device based on account information)

Regarding Claims 8, 19, Multer discloses a method, system as described in Claims 6, 17 wherein said authority is established via a user confirmation that is made in response to a user message displayed on a display screen of said second mobile computing device. (Multer col 12, ll 29-36; col 32, ll 23-28: user interface)

Regarding Claims 9, 20, Multer discloses a method, system as described in Claims 1, 12 wherein said remote server is a web based server. (Multer col 31, ll 21-23: web based (i.e. HTTP) server)

Regarding Claim 10, Multer disclose a method as described in Claim 1 wherein said step d) is performed within a synchronization process between said remote server and said second mobile computing device. (Multer col 7, ll 58-64; col 14, ll 18-19: synchronization process for information within server and handheld device)

Regarding Claim 11, Multer disclose a method as described in Claim 1 wherein the step d) is performed within a synchronization process between a host computer system and said second mobile computing device. (Multer col 7, ll 58-64; col 14, ll 18-19: synchronization process for information in server and two devices (i.e. host system and handheld device))

Regarding Claim 12, Multer discloses a system comprising:

- a) a receiver mobile computing device; (Multer col 4, ll 25-36; col 5, ll 17-21: receiver system (i.e. handheld device))
- c) a sender mobile computing device for causing said account to be modified to identify an information that resides on said remote server but not on said receiver mobile computing device; (Multer col 33, ll 13-17: update information within server system)
- d) wherein said receiver mobile computing device is for establishing a connection with said remote server; (Multer col 5, ll 10-17; col 8, ll 16-19: handheld device communicating through connection between server and handheld device) and

Multer discloses wherein said remote server is for automatically determining, from said account that said information is new to said receiver mobile computing device and automatically for downloading said information to said receiver mobile computing device. (Multer col 17, ll 15-20; col 32, ll 14-17; col 16, l 50: server management system for accounting information; col 34, ll 23-29: information updated (i.e. new information)) Multer does not specifically disclose a remote server containing an account reserved for said receiver mobile computing device which describes a complement of information stored in the receiver mobile computing device.

However, Coppinger discloses:

- b) a remote server containing an account reserved for said receiver mobile computing device which describes a complement of information stored in the receiver mobile computing device; (Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless (mobile computing) device accounting information on a network connected server)

It would have been obvious to one of ordinary skill in the art to modify Multer for a remote server containing an account which describes a complement of information stored in the receiver mobile as taught by Coppinger. One of ordinary skill in the art would have been motivated to employ the teachings of Coppinger in order to enable the additional and extended capability for the transfer over the wireless communication link and execution of transferred application programs on a handheld wireless device. (Coppinger para 003, ll 7-13)

Regarding Claim 13, Multer discloses a system as described in Claim 12 wherein said sender mobile computing is for sending said remote server a token identifying both said information and said receiver mobile computing and wherein said token causes said remote server to modify said account. (Multer col 5, ll 17-21; col 6, ll 16-20; col 37, ll 62-65: data pack (i.e. token) utilized to modify user information)

Regarding Claim 17, Multer discloses a system as described in Claim 12 wherein said remote server is also for determining if said sender mobile computing device has authority to download to said receiver mobile computing device as a precursor to downloading said information to said receiver mobile computing device. (Multer col 4, ll 25-36; col 6, ll 16-20: authorization for device, download information to device)

Regarding Claim 21, Multer discloses a system comprising:

- a) a receiver mobile computing computer; (Multer col 4, ll 25-36; col 5, ll 17-21: receiver system (i.e. handheld device))
- c) a sender mobile computing computer for causing said account to be modified to identify an information that resides on said web based server but not on said receiver mobile computing computer; (Multer col 17, ll 15-20: update accounting information managed within management (i.e. web based)server)
- d) wherein said receiver mobile computing computer is for establishing a connection with said web based server; (Multer col 5, ll 10-17; col 6, ll 16-20: handheld

device communicating through connection between server and handheld device)

Multer discloses wherein said web based server automatically determines, from said account, that said information is new to said receiver mobile computing computer, also determines if said sender mobile computing computer has authority to download to said receiver mobile computing computer, and, if so, automatically downloads said information to said receiver handheld computer. (Multer col 34, ll 23-29: update user information (i.e. new information)) Multer does specifically disclose the capability for a web based server containing an account reserved for said receiver mobile computing computer which describes a complement of information stored in the receiver mobile computing computer.

However, Coppinger discloses:

- b) a web based server containing an account reserved for said receiver mobile computing computer which describes a complement of information stored in the receiver mobile computing computer; (Coppinger para 059, ll 1-34; para 060, ll 1-7; para 060, ll 21-29: wireless (mobile computing) device accounting information on a network connected server; para 032, ll 8-13; para 035, ll 1-5: web server)

It would have been obvious to one of ordinary skill in the art to modify Multer for a web based server with an account which describes a complement of information stored in the receiver mobile computing computer as taught by Coppinger. One of ordinary skill in the art would have been motivated to employ the teachings of Coppinger in order to enable the additional and extended capability for the transfer over the wireless communication link and execution of transferred application

programs on a handheld wireless device. (Coppinger para 003, ll 7-13)

Regarding Claim 22, Multer discloses a system as described in Claim 21 wherein said sender mobile computing is for sending said remote server a token identifying both said information and said receiver mobile computing and wherein said token causes the web based server to modify said account. (Multer col 17, ll 15-20; col 37, ll 62-65: data pack (i.e. token) used to manage accounting information within management server (i.e. remote server))

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYUNG H. SHIN whose telephone number is (571) 272-3920. The examiner can normally be reached on 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. FLYNN can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyung Hye Shin
Examiner
Art Unit 2143

KHS
July 12, 2008

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2143